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Michael J. Murphy

(Typed Name and Signature of Person Mailing Paper or Fee)

PATENT
Attorney Docket No. 16286-702

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Robert John Mabbott)	Legal Examiner: Peter F. Kratz
)	
Application No. : 08/716,360)	Group Art Unit: PCT Legal Office
)	
Based on PCT/GB95/00601)	
)	
US Filing Date: September 17, 1996)	
)	
For: TRANSFER MATERIALS)	

Renewed Petition Under 37 CFR 1.47(b)

Box PCT
Assistant Commissioner for Patents
ATTN: International Division, Legal Staff
Washington, D.C. 20231

Dear Sir:

In response to the *Decision on Petitions* dated 13 Jan. 1998, applicant herewith submits the *Declaration of Facts in Support of Filing Resulting From Unavailability of Inventor* of Roger Bruce Thomson and a *Petition for Extension of Time*.

In the Decision, the Legal Examiner indicates a "petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) application has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. Petitioner has satisfied items (1), (3), (5) and (6) above."

Applicant submits herewith the *Declaration of Facts in Support of Filing Resulting From Unavailability of Inventor* of Roger Bruce Thomson, who is the attorney of record in the United Kingdom for applicant. Mr. Thomson states in paragraph III of the Declaration that in addition to

the attempt to contact Mr. Mabbott detailed in the previously submitted Declaration of Facts. Mr. Thomson personally visited Mr. Mabbott's last known address and confirmed that he was no longer there. Additionally, a search of the local telephone directory for Mr. Mabbott was also unsuccessful. We believe that this Declaration confirms item (2) that the inventor "cannot be reached after diligent effort."

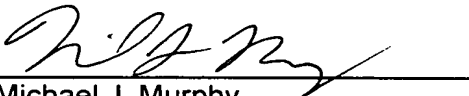
With respect to item (4) above, the legal examiner stated that the *Combined Declaration and Power of Attorney* previously submitted to the USPTO did not indicate the title of the person signing on behalf of the legal entity. The *Combined Declaration and Power of Attorney* previously submitted to the USPTO was executed by Alan Brian Porter who is a Director of ISO Development, Ltd. Applicant believes that these declarations overcome the objection of item (4) above.

The Commissioner is hereby authorized to charge any fees that may be required by this paper, and to credit any overpayment, to Deposit Account No. 23-2415 (Our Docket No. 16286.702). A duplicate of this paper is enclosed.

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI

By


Michael J. Murphy
Registration No. 37,404

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Michael J. Murphy

PATENT
Attorney Docket No. 16286-702

In re Application of:

Legal Examiner: Peter F. Kratz

Group Art Unit: PCT Legal Office

For: **TRANSFER MATERIALS**

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Assistant Commissioner for Patents
Attn: International Division
Legal Staff
Washington, D.C. 20231

The following extension of time is requested to respond to the *Decision on Petitions* dated 13 JAN 1998:

- [X] four months to July 13, 1998; the extension fee is \$755.00.
 [] The shortened statutory period has been reset by an Advisory Action dated _____.
 [] A check in the amount of \$_____ is enclosed.
 [X] Charge \$755.00 to Deposit Account No. 23-2415.

The Commissioner is hereby authorized to charge any fees that may be required by this paper, and to credit any overpayment, to Deposit Account No. 23-2415 (Our Docket No. 16286.702). A duplicate of this paper is enclosed.

By

Michael J. Murphy, Registration No. 37,404

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Palo Alto, CA 94304-1050
(650) 493-9300

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Robert John Mabbott

For: Transfer Materials

the specification of which:

- ☒ was filed on September 17, 1996 as Application No. 08/716360
- ☒ was described and claimed in International Application No. PCT/GB95/00601 filed on March 17, 1995

**DECLARATION OF FACTS IN SUPPORT OF FILING RESULTING FROM
UNAVAILABILITY OF INVENTOR**

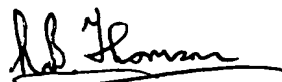
- I. I, Roger B Thomson, residing at 324 Norton Way South, Letchworth, Hertfordshire SG6 1TA, England declare that I am a United Kingdom chartered patent attorney and a European patent attorney. I am a partner in the firm of W P Thompson & Co. I was instructed by ISO Developments Limited to represent them in respect of this United States patent application and corresponding applications in other countries based upon the original UK patent application GB 9405374.1. I have already made a DECLARATION OF LAW dated March 19, 1997 in this application.
- II. I assumed responsibility for the prosecution of the patent applications relating to this invention in June 1996. Previously, the applications had been dealt with by Mr Peter Oliver of the firm of Beachcroft Stanleys. A DECLARATION OF FACTS by Peter Oliver dated 9th August 1995 has been filed as an attachment to the DECLARATION OF FACTS made by Alan Brian Porter dated 19th March 1997 in this application.

The decision by ISO Developments Limited to proceed with this application in the USA by conversion from the International patent application PCT/GB95/00601 was made at a meeting which I attended in Sandy, Bedfordshire at the offices of ISO Developments Limited on 5th September 1996. Present at that meeting were Alan Porter and Tony Bygraves, both Directors of ISO Developments Limited. It was at that meeting that Alan Porter explained the history of their relationship with Mr Mabbott. He stated that since June 1995 when Mr Mabbott refused to sign the papers for the earlier US patent application serial number 08/454,334 Mr Mabbott had left ISO Developments Limited and he itemised to me the efforts which they had made to make contact with him, those efforts being set out in Mr Porter's DECLARATION OF FACTS dated 19th March 1997.

- III. I explained at that meeting on 5th September 1996 that it is a requirement of practice in the USA that a diligent effort must be made to obtain the signature of the or each named inventor. Because the various attempts made to contact Mr Mabbott as itemised in Mr Porter's DECLARATION OF FACTS had already been undertaken, without success in tracing him, I myself made a further effort to contact him at his last known address, namely 3 Lincoln Court, Tennyson Road, Bedford, England. A personal visit by me to that address confirmed that he was no longer there and was unknown to the occupants. I also checked in the local telephone directories for any entry under R J Mabbott, but again without finding any entry. Neither I nor Mr Porter could think of any further effort which might be made to trace him. It is my opinion that the earlier efforts of Mr Porter and my subsequent attempts to find the location of Mr Mabbott were diligent. I could think of no further avenue which might be explored.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: July 9, 1998



(Signature of patent attorney making this declaration)

Roger Bruce Thomson
Chartered Patent Attorney
European Patent Attorney